

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1, 2, 6-9, 11-20 and 24-28.

The following claims are *independent*: 1, 16, 20 and 28.

The following claims have previously been *cancelled* without prejudice or disclaimer: 3-5, 10 and 21-23.

Please *amend* claims 1, 16, 20 and 28; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-2, 6-9, 11-20 and 24-28 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states "claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection." MPEP § 2106 also discusses "[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be." Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature.

Furthermore, the Supreme Court recently decided *Bilski v. Kappos*, 561 U.S. ____ (2010) No. 08-964. In that case, the majority opinion of the Supreme Court indicated that "nothing in today's opinion should be read as endorsing interpretations of §101 that the Court of Appeals for the Federal Circuit has used in the past. See, e.g., *State Street*, 149 F. 3d, at 1373; *AT&T Corp.*, 172 F.3d at 1357." (*Bilski* at 16) Further, the Supreme Court has indicated that "[t]he machine-or-transformation test is not the sole test. . ." but stated that "the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101." (*Bilski* at 8).

Applicant asserts that the pending claims at a minimum meet the machine-or-transformation test and as such recite patentable subject matter in accordance with §101.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claims 1-2, 6-9, 11-20 and 24-28 allegedly conflict with the machine-or-transformation test and could be interpreted as directed to non-statutory subject matter. Accordingly, Applicant submits that claims 1-2, 6-9, 11-20 and 24-28 are directed to statutory subject matter, and respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1, 2, 6-9, 11-20 and 24-28 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses the rejection(s), and submits that the noted claims all satisfy the requirements of 35 U.S.C. § 112.

Although Applicant traverses the Examiner's assertions and submit the claims as previously pending and amended comply with 35 U.S.C. § 112, Applicant has amended these claims to further clarify the claim elements. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-2, 6-9, 11-20, and 24-28 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Heckman, US Patent No. 5,875,431 (hereinafter

“Heckman”), and in further view of Halligan et al., US Patent Pub No. 2002/0077941 (hereinafter “Halligan”).

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, “the obviousness or nonobviousness of the subject matter [be] determined,” and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A)** the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B)** the difference or differences in the claim over the applied reference(s);
- (C)** the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D)** an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(B) and (C)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do not discuss, do not render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in amended independent claim(s) 1, 16, 20 and 28:

...

calculating, by the computer, a risk quotient for the legal action by summing the plurality of risk factor values; deriving a scaled numeric value indicative of an amount of risk associated with the legal action; and generating by the computer, based on the derived scaled numeric value, a suggested action associated with the corresponding legal action.

...

Examiner admits that Heckman does not disclose at least assigning a numerical value to each of a plurality of risk assessment factors, ... (Office Action, page 11).

The Examiner turns to Halligan to remedy the deficiencies in the Heckman reference. The Examiner states that Halligan discusses a

trade secret documentation tool used to prepare reports and court exhibits documenting employee and outsider exposure to trade secrets so as to be used at the time of litigation by assigning a numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors (*Figure 4 Enter values of the five factors for the Trade Secret, page 2 [0020-0023], page 6 [0094-0095], page 7 [0096] steps of applying a plurality of generally accepted legal criteria to the content of a trade secret, **assigning a value under each criterion; applying generally accepted legal criteria (e.g. the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts; page 2 [0020-0023], page 6 [0095], and page 7 [0096-0098]***

(Office Action, pages 12 emphasis in Office Action).

Instead of the claimed elements, Halligan actually discusses that its "accounting system may calculate various weightings of the six factors for each trade secret to provide information to the accounting system's users on the protectability and other features of the trade secret." (Halligan, page 6 para. [0095], emphasis added). Halligan discusses its method with respect to user assessed values associated with the protectability of trade secrets. However, Applicant submits that neither Halligan's trade secret protectability metric, nor Heckmans system for legal billing, milestone assessment and scheduling deliverables (Heckman, Abstract) are different from the claimed Combining it with Heckman still does not provide the claimed:

...

calculating, by the computer, a risk quotient for the legal action by summing the plurality of risk factor values;

deriving a scaled numeric value indicative of an amount of risk associated with the legal action; and generating by the computer, based on the derived scaled numeric value, a suggested action associated with the corresponding legal action.

...

as recited by amended independent claim 1.

Although of different scope than claim 1, Applicants submit that claims 16, 20 and 28 are patentable over Heckman in view of Halligan, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Furthermore, Applicants submit that claims 2, 6-9, 11-19 and 24-27 which depend directly or indirectly from independent claims 1, 16 and 20 are also not discussed or rendered obvious by Heckman or Halligan taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter “Office Action(s)”). While many other claim elements and/or bases

for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1, 2, 6-9, 11-20 and 24-28, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated

from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209.451. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209.451.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
Attorney(s) for Applicant,
CHADBOURNE & PARKE LLP

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By:/Daniel C. Sheridan/
Daniel C. Sheridan
Registration No.: 53,585

Correspondence Address:

CHADBOURNE & PARKE LLP
30 Rockefeller Plaza
New York, NY 10112

212-408-5100 (Telephone)
212-541-5369 (Facsimile)
patents@chadbourne.com (E-mail)